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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,766	11/27/2001	Takahiro Tochioka	740819-705	7593
22204	7590	02/02/2005	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/993,766

Applicant(s)

TOCHIOKA ET AL.

Examiner

Callie E. Shosho

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 29 December 2004. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112, 1st paragraph rejection.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 10, 12, 24 and 25.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' amendment filed 12/29/04 overcomes the 35 USC 112, 1st paragraph rejection of record. However, applicants' amendment and arguments filed 12/29/04 do not overcome the 35 USC 103 rejection of record.

Specifically, applicants argue that Yoshino (U.S. 5,514,745) is not a relevant reference against the present claims given that Yoshino (i) discloses melt flow rate lower than presently claimed, (ii) discloses Izod impact values which are in direct contrast to those of the present invention, and (iii) fails to disclose overcoming low mechanical properties of the molded article by using homopolypropylene having high pentad isotactic index as recited by the claimed invention.

With respect to argument (i), applicants note that examples 1 and 2 of Yoshino disclose melt flow rate of the matrix polymer of 82 g/10 min and 92 g/10 min, respectively, which are lower than that of the present invention.

However, these are just two examples of Yoshino. Examples 3, 4, and 5 of Yoshino all disclose melt flow rate of the matrix polymer that fall within the scope of the present claims, i.e. 125 g/10 min, 190 g/10 min, and 280 g/10 min, respectively.

With respect to argument (ii), it is noted that there is no requirement in the present claims regarding Izod impact values and thus, the present claims are open to resin material with any Izod impact values including those disclosed by Yoshino.

With respect to argument (iii), it is agreed that there is no disclosure in Yoshino of homopolypropylene having high pentad isotactic index which is why Yoshino is used in

combination with Mitsuno et al. (U.S. 5,409,991) which teach using polypropylene with pentad isotactic index as presently claimed.

Applicants also argue on pages 7-8 of the amendment that how the invention of Yoshino works is different than how the present invention works and thus, Yoshino fail to disclose or suggest features of the present invention. However, the present claims are drawn to long glass fiber filler reinforced resin material not a method of making such material. While it is agreed that there is no disclosure in Yoshino of polypropylene with pentad isotactic index as presently claimed or ethylene propylene block copolymer having islands-sea structure as presently claimed, this is why Yoshino is used in combination with Mitsuno et al. and Fujii et al. (U.S. 4,334,040). The combination of these references clearly discloses all the limitations of the present claims.

With respect to Mitsuno et al., applicants argue that Mitsuno et al. requires rubber-like material (H) and/or modified rubber-like material (I) which is significantly different from that of the present invention.

However, it is noted that in light of the open language of the present claims, i.e. long glass fiber filler reinforced resin material "comprising", the present claims are open to the inclusion of additional ingredients including rubber-like material (H) and/or modified rubber-like material (I) as disclosed by Mitsuno et al.

Applicants also argue that the presence of the rubber-like material (H) and/or modified rubber-like material (I) causes the resin material of Mitsuno et al. to not achieve high Izod impact values and high bending modulus simultaneously.

However, applicants have offered no evidence to support this position. Further, there is no requirement in the present claims regarding either Izod impact values or bending modulus. Additionally, it is noted that Mitsuno et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely that the use of polypropylene with pentad isotactic index of 97% or greater produces composition with high heat resistance, stiffness, and scratch resistance, and in combination with the primary reference, discloses the presently claimed invention.

Applicants also argue that Mitsuno et al. fail to disclose using homopolypropylene having high pentad isotactic index in order to overcome low mechanical properties due to the use of homopolypropylene having high melt flow rate.

However, while the motivation of Mitsuno et al. for using polypropylene with pentad isotactic index as presently claimed may not be the same motivation as in the present invention, it is noted that obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

Applicants also argue that Mitsuno et al. disclose polypropylene resin with melt flow rate of 0.1-100 g/min, preferably 0.5-40 g/10 min, and thus Mitsuno et al. do not utilize matrix polymer with high melt flow rate as required in the present claims. Applicants point to examples 22 and 45 of Mitsuno et al. that utilize polypropylene with melt flow rate of 36 g/10 min and 21 g/10 min, respectively.

However, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of the reference as a whole discloses polypropylene with melt flow rate of 0.1-100 g/10 min which, although there is overlap at only one point, still overlaps the presently claimed melt flow rate. Further, it is noted that Mitsuno et al. is not used for its teaching of the melt flow rate of homopolypropylene. Yoshino already teaches this.

On page 10 of the amendment, applicants set forth a table that discloses bending modulus and Izod impact values of the resin material of examples 22 and 45 of Mitsuno et al. It is shown that these values are far lower than those of the present invention.

However, given that these examples utilize polypropylene with melt flow rate outside the scope of the present claims as described above, one would not expect the resin material of these examples to possess bending modulus and Izod impact values comparable to the resin material of the present invention. Further, it is significant to note that the Mitsuno et al. reference is not utilized against the present claims alone but rather is used in combination with Yoshino et al. Given that the combination of Yoshino and Mitsuno et al. disclose polypropylene possesses melt flow rate and pentad isotactic index as presently claimed, it is clear that such resin material would intrinsically possess Izod impact values and bending modulus as presently claimed.

Applicants also argue that there is no motivation to combine Yoshino with Mitsuno et al.

It is noted that Yoshino disclose long glass fiber filler reinforced resin material comprising polypropylene matrix resin with melt flow rate as presently claimed, however, there is no disclosure of the pentad isotactic index as presently claimed. Mitsuno et al., which is drawn to resin composition comprising homopolypropylene and glass fiber, disclose using homopolypropylene with pentad isotactic index of 97% or greater in order to produce composition with high heat resistance, stiffness, and scratch resistance. Thus, it is the examiner's position that the combination of Yoshino with Mitsuno et al. is proper given that there is good motivation to combine the reference.

Applicants argue that Yoshino, Mitsuno et al., and Fujii et al. fail to disclose or suggest using homopolypropylene having a high melt flow rate to suppress breakage of long glass fiber filler.

However, given that Yoshino do disclose using homopolypropylene with melt flow rate as presently claimed, it is clear that the homopolypropylene of Yoshino would intrinsically suppress breakage of the glass fibers.

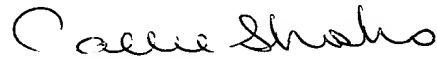
Applicants argue that the combination of references utilized by the examiner do not disclose the present invention.

However, as seen in paragraph 5 of the office action mailed 6/29/04, it is clear that the combination of Yoshino, Mitsuno et al., and Fujii et al. meet all the requirements of the present claims. While the combination of references may not disclose using homopolypropylene having pentad isotactic index to overcome low mechanical properties due to the homopolypropylene

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having high melt flow rate, as argued by the examiner above, obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation.

In light of the above, it is the examiner's position that the combination of Yoshino with Mitsuno et al. and Fujii remains relevant against the present claims.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
2/1/05